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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 10/820,932   | 04/08/2004  | Samuel S. Fields     | 41615-0003                | 9731             |
| 43463  | 7590        | 12/21/2005           |                           |                  |
| RUDEN, MCCLOSKEY, SMITH, SCHUSTER & RUSSELL, P.A.<br>222 LAKEVIEW AVE<br>SUITE 800<br>WEST PALM BEACH, FL 33401-6112 |             |                      | EXAMINER<br>CHAN, KO HUNG |                  |
|  |             |                      | ART UNIT                  | PAPER NUMBER     |
|  |             |                      | 3632                      |                  |
| DATE MAILED: 12/21/2005  |             |                      |                           |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/820,932 | <b>Applicant(s)</b><br>FIELDS, SAMUEL S. |  |
|                              | <b>Examiner</b><br>Korie H. Chan     | <b>Art Unit</b><br>3632                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US patent no. 3,151,793). Smith discloses a holder inherently capable of being a condiment container holder comprising a plurality of walls (12 and 13) each walls having a top lip (bend portion at top edge of wall 20, figure 4) on an upper portion thereof for retaining container (18), a bottom (11, figure 2) engaged to plurality of walls, the bottom having a bottom lip (16 and 17) on each end portion thereof and the bottom having a condiment well (26) formed therein inherently capable of receiving liquid condiment.

Applicant's recitation to the liquid condiment is of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US patent no. 3,151,793) in view of Feerick (US patent no. 2,491,652). Smith disclosed all the claimed features of applicant's invention except for a condiment container. Feerick teaches a holder supporting condiment containers (15). It would have been obvious to one of ordinary skill in the art to place condiment containers into the holder of Smith for holding condiments as taught to be desirably by Feerick.

Claims 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US patent no. 3,151,793) in view of Grondin (US patent no. 3,168,275). Smith disclosed all the claimed features of applicant's invention except for using adhesive material for mounting to engage the bottom or wall. Smith uses fasteners to mount the holder. However, to substitute mounting fasteners with adhesives are notoriously old and well-known. Such modification has the known advantage of eliminating damage to a wall surface to which the holder is to be mounted. Grondin teaches a holder with walls (20) with lips (24) and bottom (18) engage the walls wherein releasable adhesive material (30, figure 2, 32, figure 3) can engage the bottom (18, figure 2) or the wall (20, figure 3) to alternatively mount the holder under different conditions. It would have been obvious to one of ordinary skilled in the art to substitute the mounting fasteners of Smith with releasable adhesive as taught by Grondin to

prevent damage to a wall surface and to provide the adhesive material at either the bottom or wall as taught by Grondin to facilitate alternative mounting under different orientation.

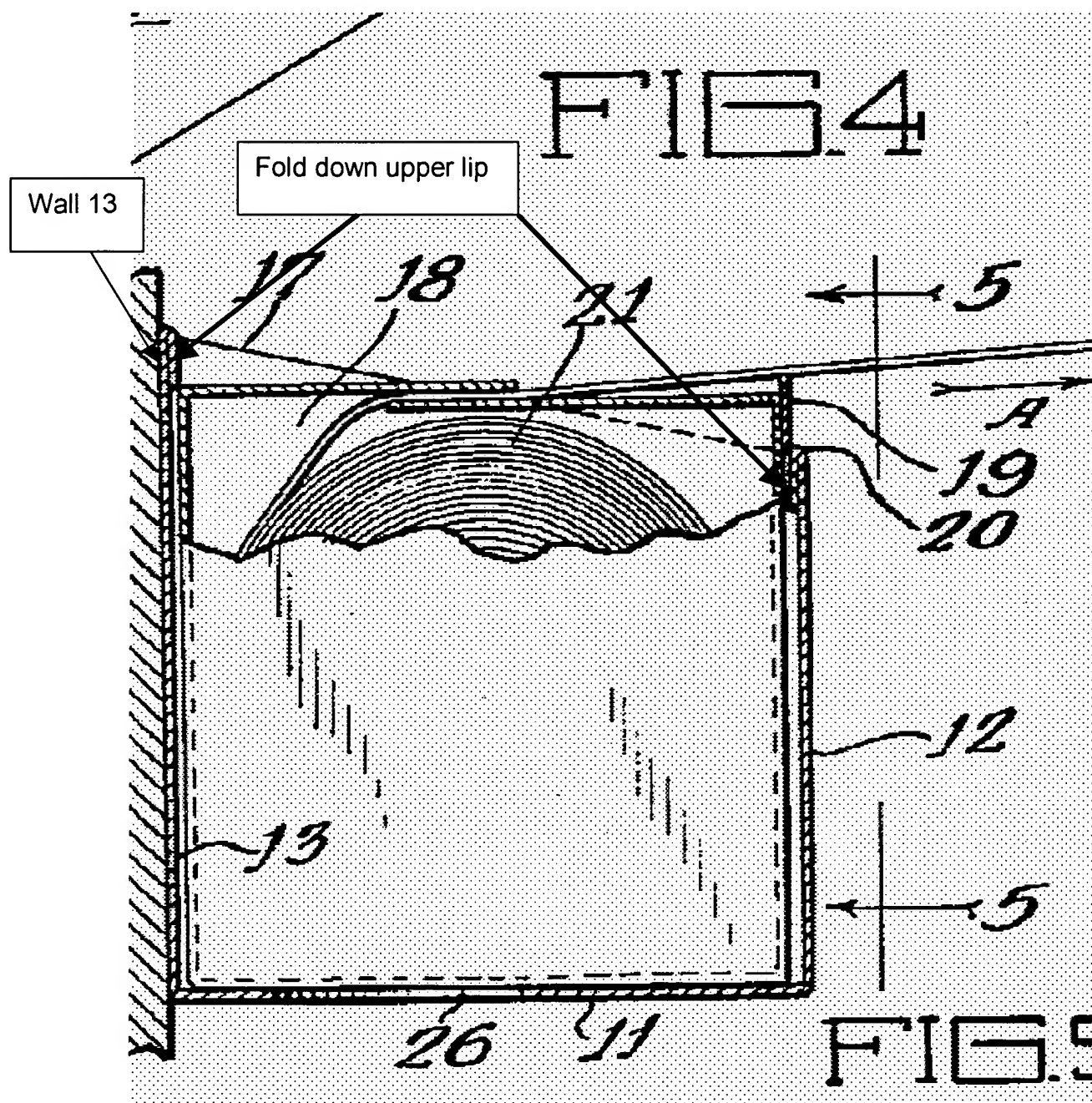
### ***Response to Arguments***

Applicant's arguments filed October 11, 2005 have been fully considered but they are not persuasive. Applicant argues that Smith does not teach wall having a top lip on an upper portion thereof but rather Smith shows a holder having edges which are not suitable for the purpose of preventing the condiment container from escaping upwards or sideways. Examiner disagrees. Smith does show inwardly bent lips 20 on upper portion of walls. Whether these edges prevent a container from escaping upward is irrelevant since such limitation is not claimed. Further, a container that is disposed just below the bottom distal edge of the lip at 20 would have been prevented from escaping upward (see figure 4). Applicant argues that the aperture 26 of Smith is not a recess and is not adequate for containing a liquid. Examiner disagrees. An aperture constitutes a recess by definition. The argument that the aperture is not adequate for containing a liquid is without support. Indeed liquid container come in different sizes. Smith's aperture inherently is capable of supporting a liquid condiment as recited in claim 3. Applicant is reminded that the liquid condiment is of intended use in claims 1 and 3. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding Smith and Feerick combination against claim 2 and Smith and Grondin combination against claims 4 and 5, applicant argues that neither references teach plurality of walls having a top lip on an upper portion thereof and a bottom lip on each end thereof and a condiment well formed therein. Examiner disagrees. All the referenced features are shown by Smith as discussed above. Feerick teaches placing condiment containers or boxes to be placed in a channel type holder similarly found in primary reference of Smith where the channel holder is used to hold a box type container (the dispensing carton). To place condiment container of Feerick onto the channel type holder of Smith would have been obvious for supporting a different type containers. Grondin was applied to teach adhesive mounting. To provide adhesive to the wall (13) of Smith are provided would have been obvious as such modification involves one well-known method of mounting to another. The wall 13 of Smith is a wall for mounting. Applicant's argument of providing the lip 24 onto Smith's end wall would have made Smith's device inoperative is not understood. The rejection is not about modifying or providing a lip to Smith's device as discussed above. Smith already disclose a folded down lip at 20 (see illustration next page) and also lips or end walls 14 and 15 at each end.



Examiner's illustration of Smith reference

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Korie H. Chan  
Primary Examiner  
Art Unit 3632

khc  
December 15, 2005